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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/997,915

11/29/2001

Bhupesh Gupta

AUS920010888US1

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05/21/2009

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EXAMINER

NGUYEN, CHAU T

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

05/21/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* BHUPESH GUPTA

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Appeal 2008-4737  
Application 09/997,915<sup>1</sup>  
Technology Center 2100

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Decided<sup>2</sup>: May 21, 2009

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*Before:* HOWARD B. BLANKENSHIP, JAY P. LUCAS, and  
THU A. DANG, *Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

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<sup>1</sup> Application filed November 29, 2001. The real party in interest is International Business Machines Corporation.

<sup>2</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail date (paper delivery) or Notification Date (electronic Delivery).

## STATEMENT OF THE CASE

Appellant appeals from a multiple rejection of claims 1 to 33 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellant's invention relates to a method and system for automatically placing bookmarks for web pages into categories and subcategories. In the words of the Appellant:

An active Web user may access and bookmark a great number of Web pages within a short span of time. Thus, to easily locate and access the bookmarked Web pages, the user has to arrange them in the folder in a logical manner. There are a number of available bookmark management tools that may be used to achieve this task. However, all of them require that the user actively manage the folder.

(Spec. 3, ll. 1-7).

A method, system and apparatus for arranging bookmarked Web pages into categories in a bookmark folder are provided. When a Web page is to be bookmarked a search is initiated on a Web portal to determine under which category the Web page may be found. If the Web page is found into a category, the category is downloaded for use as a name to a sub-folder into which the bookmark to the Web page will be stored. If the category is not found, the bookmark to the Web page will be stored into a default sub-folder and a note may be sent to the Web portal requesting that the Web page be assigned into a category. After the Web page is assigned into a category, the category may be downloaded for use as name to the tagged sub-folder.

(Spec. 30, Abstract).

Claim 1 is exemplary:

1. A computer implemented method of categorizing bookmarked Web pages in a bookmark folder comprising the steps of:
  - determining whether a Web page to be bookmarked has been assigned a category on a server;
  - downloading the category if the Web page has been assigned a category;
  - creating a sub-folder in the bookmark folder with the category as a name; and
  - storing a bookmark to the Web page into the sub-folder.

#### PRIOR ART

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Khan

6,546,393 B1

Apr. 8 2003

#### REJECTION

The Examiner rejects the claims as follows:

R1: Claims 1 to 33 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Khan.

Groups of Claims:

The claims will be discussed in the order argued.

Appellant contends that the claimed subject matter is not anticipated by Khan for failure of that reference to teach claimed limitations. The Examiner finds that each of the claims is properly rejected.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this opinion. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

We affirm the rejection.

### ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 102(e). The issue turns on whether Khan teaches downloading the category into which a bookmark belongs (e.g. travel, news) and other claimed elements.

### FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellant has invented a method and apparatus for organizing bookmarks of specific user selected web pages into categories in an automatic manner using the categories provided by Web portals. (Spec. 12, ll. 4-12). Users can create new categories and sub-categories of their own choosing. (Spec. 13, generally).
2. The reference Khan teaches a system for organizing bookmarks for users at the server level, adding categories and subcategories chosen by the users. (Col. 11, l. 63 to col. 12, l. 27).

## PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

"Anticipation of a patent claim requires a finding that the claim at issue 'reads on' a prior art reference." *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999). "In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art." *Id.* (internal citations omitted).

[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed *but also all of the limitations arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of

the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

*Net MoneyIN, Inc. v. VeriSign et al.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (emphasis added).

## ANALYSIS

From our review of the administrative record, we find that Examiner has presented a prima facie case for the rejections of Appellant's claims under 35 U.S.C. § 102(e). The prima facie case is presented on pages 3 to 7 of the Examiner's Answer. In opposition, Appellant presents a number of arguments.

*Arguments with respect to the rejection  
of independent claims 1, 9, 17, 25, and 33  
under 35 U.S.C. § 102 [R1]*

Appellant contends that the Examiner erred in rejecting claims 1, 9, 17, 25, and 33 and the claims dependent thereon for being anticipated by Khan. (App. Br. 5, top). Appellant discusses the Khan reference, and recognizes that Khan manually or automatically places web pages sent by a user to a server into categories represented by bookmark folders on the server. (App. Br. 5, middle). "However, nowhere in the disclosure does Khan teach, show or so much as suggest the steps of downloading a category if it has been determined that a web page to be bookmarked has been assigned a category on a server," states the Appellant. (App. Br. 5, bottom) (underlining and bolding omitted).

We consider the paragraph of Khan starting at column 11, line 63:

Under manual categorization, the user determines the category 310*a*, 310*b*, 310*c* under which to file a bookmark or a set of bookmarks. These bookmarks as well as the suggested categorization are reviewed by the directory's editorial staff for correctness of categorization. After this screening, the sites are made part of the directory under the user recommended category or a [sic] editor selected classification, and the user is notified.

(Col. 11, l. 63 to col. 12, l. 3).

We note in this paragraph that after the editorial staff screens the proposed categories for web pages, the user is notified of them. (Col. 12, l. 3). We find this notification anticipates the claim limitation, as the category is downloaded to the user by the server.

Appellant further argues that the Examiner did not indicate where in the disclosure Khan teaches the step of “creating a subfolder in the bookmark folder with the category as a name, and storing a bookmark to the Web page into the sub-folder.” (App. Br. 7, middle) (bolding and italics omitted). The Examiner has pointed to column 12, lines 60-62 in Khan for the teaching of creating sub-categories, and we do not find error in using Khan’s teachings on this point. We also note in Figure 3 of Khan that the Subcategory 1A, for example, has the category name 1A, taken from the web sites 1Ai, 1Aii, etc., stored in its subfolder. We thus find the claim anticipated by Khan on this point.

Finally with respect to claims 6, 14, 22, and 30, Appellant further contends that Khan “does not teach the step of downloading URLs for Web pages to be bookmarked. Rather Khan teaches the step of uploading bookmarks and presumably URLs of pages to be bookmarked.” (App. Br. 7, bottom). The Examiner points to Figure 11, which does indeed teach



downloading URL for bookmarks with the category names as claimed.  
(Answer 9, top). We additionally point out in the reference Khan, column 12, line 3, and Figure 4 which disclose the downloaded web pages, categories and bookmarks going to the user.

In short, we do not find that the Appellant has shown error in the rejection over Khan.

### CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner has not erred in rejecting claims 1 to 33 under 35 U.S.C. § 102(e) over Khan.

### DECISION

The Examiner's rejection of claims 1 to 33 [R1] is Affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

### AFFIRMED

msc

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